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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,334

04/25/2006

Mitsuhiro Hamashima

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EXAMINER

KAU, STEVEN Y

ART UNIT

PAPER NUMBER

2625

NOTIFICATION DATE

DELIVERY MODE

12/03/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail@rkmlegalgroup.com

Office Action Summary	Application No.	Applicant(s)	
	10/573,334	HAMASHIMA ET AL.	
	Examiner	Art Unit	
	STEVEN KAU	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 12, 13 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 12, 13 and 37-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/4/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement

1. Applicant's amendment was received on 9/11/2009, and has been entered and made of record.

Status of the Claims

2. Claims 1-7, 8-11, and 14-36 have been canceled. Claims 37, 38, and 39 have been added, and claims 7, 12, 13, and 37-39 are pending for further examination in this Action.

Response to Remark/Arguments

3. Applicant's arguments with respect to claims 7, 12 and 13 have been fully considered but are moot in view of the new ground(s) of rejection due to the amendments.

- This is a non-final office Action due to a new ground of rejection, i.e. 35 USC 112, second paragraph rejection is introduced.
- The amended claims submitted on 9/11/2009 indicating that the application serial number is 10/573,344, which is incorrect. The correct serial number for the instant application is 10/537,334.
- In accordance with 37 U.S.C. 1.173(c), which requires that "***Whenever there is an amendment to the claim pursuant to paragraph (b) of this***

section, there must also be supplied, on pages separate from the pages containing the changes, the status (i.e. pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims". The examiner requests the applicants to provide supports of the changes made to the claims, i.e. "input element for inputting ~~[[an]]~~ image data, the image data including reduced image data and actual image data; output element for printing out the image data; a screen for displaying an image list display, a detailed image display and an enlarged image display, wherein the image list display includes a plural of selectable images based on the reduced image data and a mechanism for switching the selected image to the detailed image, wherein the detailed image display displays a detailed image of the selected image based on the actual image data, and wherein the enlarged image display displays an enlarged image based on the reduced image data, enlarged display setting element for performing setting in relation to whether or not ~~a reduced image data is enlarged and~~ the enlarged image display is displayed during a transition from a ~~simplified~~ the image list display based on the reduced image data to ~~[[a]]~~ the detailed image display ~~based on actual image data~~", as well as the newly added claims from the original specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7, 12, and 13 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. For instance, Claim 7 is directed to an image output apparatus for processing an image, limitations recite, "input element for inputting image data, the image data including reduced image data and actual image data; output element for printing out the image data; a screen for displaying an image list display, a detailed image display and an enlarged image display, wherein the image list display includes a plural of selectable images based on the reduced image data and a mechanism for switching the selected image to the detailed image, wherein the detailed image display displays a detailed image of the selected image based on the actual image data, and wherein the enlarged image display displays an enlarged image based on the reduced image data, enlarged display setting element for performing setting in relation to whether or not the enlarged image display is displayed during a transition from the image list display to the detailed image display" (emphasis added by the examiner). There is no positive structure elements/devices specified in such a manner as to present a complete operative device as required by 35 U.S.C. 112,

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second paragraph. For example, what are the structure/tangible elements or devices in the claimed that the image output apparatus relies on to input image data, to output the image data, and to set in relation to whether or not the enlarged image display is displayed? In addition, the underlined phrases are unclear in the claim, i.e. what are "input element", which can be image data in signal form being sent by a terminal in a network, or a mouse, a keyboard, a scanner, or a camera, etc., "output element", which can be an ink, or paper ejecting device, and "enlarged display setting element", which can be a circuitry, or a filter, etc. Thus, applicants failed to particularly point out and distinctly claim the subject matter. Claims 12, and 13 have the similar claim elements, i.e. "input element", "output element" and "processing element" used in the claim and are rejected under 35 U.S.C. 112, second paragraph for the same reason discussed above. The terms of "input element", "output element", "enlarged display element" and "processing element" will be given a reasonable broadest interpretation in light of the specification.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nardozzi et al (US 6,636,837) in view of Ikede et al (US 6,111,586).

Regarding Claim 7.

Nardozzi discloses an image output apparatus comprising:

input element for inputting image data (**i.e. display device 12 of Fig. 1 is also services as an input device, col 4, lines 55-66**), the image data including actual image data (**referring to Fig. 1, customer enter image data into the input device, col 4, lines 55-65**);

output element for printing out the image data (**referring to Fig. 1, Printer 16 is for outputting or printing out image data, i.e. labels and receipts, col 5, lines 5-10; and the photofinishing Lab of Fig. 2 producing image prints customarily, col 6, lines 17-32**); a screen for displaying an image list display (**referring to Fig. 1, Display 12 displays screens, and image information, i.e. a list of images downloaded by the customer, col 5, line 60 to col 6, line 4**), a detailed image display (**i.e. downloaded images are detail images**), wherein the image list display includes a plural of selectable images (**i.e. customer can further manipulate the downloaded**

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image; that is, the images displayed are selectable image for further manipulation, col 5,line 60 to col 6, line 4) and a mechanism for switching the selected image to the detailed image (**i.e. an image can be manipulated must be a detail image; that is, a switching mode to allow a customer to view and manipulate a selected image, col 5, line 55 to col 6, line 4**), wherein the detailed image display displays a detailed image of the selected image based on the actual image data (**i.e. as set forth above, downloaded images are actual images and the selected detail image for manipulation is form a set of downloaded images, col 5, line 55 to col 6, line 4**).

Nardozzi does not disclose inputting the image data including reduced image data; an enlarged image display; selectable images based on the reduced image data; and wherein the enlarged image display displays an enlarged image based on the reduced image data, enlarged display setting element for performing setting in relation to whether or not the enlarged image display is displayed during a transition from the image list display to the detailed image display.

In the same field of endeavor, Ikeda teaches inputting image data including reduced image data (**reduced photo images, or miniature photo images in the photo area 101 are arranged in the order of input; that is, reduced photo images are inputted, Fig. 1 & col 11, lines 51-57**); an enlarged image display (**i.e. photo images displayed in the screen of a display unit can be detected whether a request is to enlarging or reducing an object; that is, the screen of the display**

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unit has the capability to be an enlarged image display, col 2, lines 59-67 & col 12, lines 58-67); selectable images based on the reduced image data (referring to Fig. 14, photo images in Photo Area 101 are reduced photo images, or miniature photo images and are selectable, col 11, lines 36-50); and wherein the enlarged image display displays an enlarged image based on the reduced image data (referring to Fig. 13, a step of enlarging a photo image; a reduced photo image in the Photo Area 101 thus can be enlarged, col 12, lines 58-67), enlarged display setting element for performing setting in relation to whether or not the enlarged image display is displayed during a transition from the image list display to the detailed image display (referring to the Editing System of Fig. 2, detecting unit 20, determination unit 21, and enlarging / reduction unit 22 perform object enlargement from the inputted miniature photo images, i.e. photo area 101 as set forth above, of Fig. 14; that is, there is a transaction from the list of miniature photo images in Area 101 to an object of an miniature image to be enlarged which is being performed by Units 20, 21, & 22, col 8, lines 15-28, col 11, lines 39-57).

Nardozzi '837 and Ikeda '586 are combinable. Nardozzi '837 discloses an image output apparatus of Fig. 1 used in the photofinishing Lab of Fig. 2, for producing photo reprints customarily, and Ikeda '586 discloses detail photo image editing system, i.e. image enlargement and reduction. Thus, combining Ikeda '586 with Nardozzi '837 would have been to enhance the image output apparatus of Nardozzi to improve image reproduce quality and to satisfy with customer's need.

Having an image output apparatus of Nardozzi '837 reference and then given the well-established teaching of Ikeda '586 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image output apparatus of Nardozzi '837 reference to combine the teaching of "inputting the image data including reduced image data; an enlarged image display; selectable images based on the reduced image data; and wherein the enlarged image display displays an enlarged image based on the reduced image data, enlarged display setting element for performing setting in relation to whether or not the enlarged image display is displayed during a transition from the image list display to the detailed image display" as taught by Ikeda '586 reference since doing so would increase the versatility of the image output apparatus of Nardozzi '837 so that an image editing for correction or adjustment become available, and therefore to improve image reproduction quality; and further the disclosure provided could easily be established for one another with predictable results.

Regarding Claim 37.

Claim 37 is directed to a method claim which substantially corresponds to operation of the device in claim 7, with method steps directly corresponding to the function of device elements in claim 7. Thus, claim 37 is rejected as set forth above for claim 7.

Regarding Claim 12.

Nardozzi discloses an image output apparatus comprising: input element for inputting an image data (**i.e. display device 12 of Fig. 1 is also services as an input**

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device, col 4, lines 55-66, and customer enter image data into the input device, col 4, lines 55-65); output element for printing out the image data (referring to Fig. 1, Printer 16 is for outputting or printing out image data, i.e. labels and receipts, col 5, lines 5-10, and the photofinishing Lab of Fig. 2 producing image prints customarily, col 6, lines 17-32); and processing element for processing the image data (referring to Fig. 2, Lab 38 performs image data processing, col 6, lines 17-32), the processing element having a screen for displaying the image data to be processed (referring to Fig. 1, images downloaded to be processed are displayed in the screen, col 5, line 60 to col 6, line 4).

Nardozzi does not disclose a printout area being able to be wherein the image data can be moved on the screen by an operator within a range in which at least a part of the image data is present within a printout area.

Ikeda teaches a printout area being able to be wherein the image data can be moved on the screen by an operator within a range in which at least a part of the image data is present within a printout area (i.e. **performing image moving, rotating, etc., to avoid overlapping, and within a range so that can be automatically enlarged or reduced for image reproduction; that is, the processed image data must be within a printing area, col 2, lines 5-11 and col 9, lines 1-5).**

Having an image output apparatus of Nardozzi '837 reference and then given the well-established teaching of Ikeda '586 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image output apparatus of Nardozzi '837 reference to combine the teaching of "a printout area

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being able to be wherein the image data can be moved on the screen by an operator within a range in which at least a part of the image data is present within a printout area” as taught by Ikeda ‘586 reference since doing so would increase the versatility of the image output apparatus of Nardozzi ‘837 so that an image editing for correction or adjustment, i.e. moving or rotating an image object, become available, and therefore to improve image reproduction quality; and further the disclosure provided could easily be established for one another with predictable results.

Regarding Claim 38.

Claim 38 is directed to a method claim which substantially corresponds to operation of the device in claim 12, with method steps directly corresponding to the function of device elements in claim 12. Thus, claim 38 is rejected as set forth above for claim 12.

Regarding Claim 13.

Nardozzi discloses an image output apparatus comprising: **(i.e. display device 12 of Fig. 1 is also services as an input device, col 4, lines 55-66, and customer enter image data into the input device, col 4, lines 55-65);** output element for printing out the image data **(referring to Fig. 1, Printer 16 is for outputting or printing out image data, i.e. labels and receipts, col 5, lines 5-10, and the photofinishing Lab of Fig. 2 producing image prints customarily, col 6, lines 17-32);** and processing element for processing the image data **(referring to Fig. 2, Lab 38 performs image data processing, col 6, lines 17-32),** the processing element having a screen for displaying the image data to be processed **(i.e. downloaded images are detail**

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images), wherein the image list display includes a plural of selectable images (**i.e. customer can further manipulate the downloaded image; that is, the images displayed are selectable image for further manipulation, col 5,line 60 to col 6, line 4**) and a printout area being able to be printed (**referring to Figs. 3 and 4**).

Nardozzi does not disclose moving element for moving the image data to a position on the screen wherein at least a part of the image data is present within a printout area, when the entire image data goes over the printout area by an operator.

Ikeda teaches moving element for moving the image data to a position on the screen wherein at least a part of the image data is present within a printout area, when the entire image data goes over the printout area by an operator (**i.e. performing image moving, rotating, etc., to avoid overlapping, and within a range so that can be automatically enlarged or reduced for image reproduction; that is, the processed image data must be within a printing area, col 2, lines 5-11 and col 9, lines 1-5**).

Having an image output apparatus of Nardozzi '837 reference and then given the well-established teaching of Ikeda '586 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image output apparatus of Nardozzi '837 reference to combine the teaching of "a printout area being able to be wherein the image data can be moved on the screen by an operator within a range in which at least a part of the image data is present within a printout area" as taught by Ikeda '586 reference since doing so would increase the versatility of the image output apparatus of Nardozzi '837 so that an image editing for correction or

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adjustment, i.e. moving or rotating an image object, become available, and therefore to improve image reproduction quality; and further the disclosure provided could easily be established for one another with predictable results.

Regarding Claim 39.

Claim 39 is directed to a method claim which substantially corresponds to operation of the device in claim 13, with method steps directly corresponding to the function of device elements in claim 13. Thus, claim 39 is rejected as set forth above for claim 13.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Kau whose telephone number is 571-270-1120 and fax number is 571-270-2120. The examiner can normally be reached on M-F, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Steven Kau/
Examiner, Art Unit 2625
November 27, 2009

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625